

## REMARKS

The Office Action mailed August 16, 2007 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

Applicant has amended the claims to attend to housekeeping matters and to more clearly describe the invention. Claim 1 was amended to replace the term "at least one of the monovalent and divalent metal cations, trivalent cations" by the term —a combination of trivalent and divalent and optionally monovalent metal cations—and to recite the salt has hydroxyl groups wherein the number of hydroxyl groups in the layered double hydroxide salt ranges from 1.8 to 2.2 times the sum of all the metal cations and wherein the layered double hydroxide salt contains  $Mg^{2+}$  and  $Al^{3+}$ . Claim 1 was amended to remove the redundant term "and in" in line 3. Support for this amendment may be found in Applicant's Specification on page 6, lines 10-13, and in originally filed claims 2 and 4. Claims 3, 5, and 8 were amended to attend to formality issues in referring to amended claim 1 in reciting the layered double hydroxide salt term and in properly referring to organic anions. Claim 12 was amended to replace the term "at least one of the monovalent and divalent metal cations, trivalent metal cations" with the term —a calcined hydrotalcite or an uncalcined hydrotalcite—. Support for this amendment may be found in Applicant's Specification at page 8, lines 18 and 25, and in originally filed claim 12. It is believed that no new matter has been introduced by this amendment.

The objection to claim 1 for informalities should be withdrawn in view of Applicant's amendment which removed the term "and in".

Claims 7 and 8 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The rejection of claims 7 and 8 as amended under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention should be

withdrawn in view of Applicant's amendments which cancel claim 7 and now properly recite organic anions.

Claims 1-3, 6-8, 10, 11, 15-17, and 22-24 were rejected under 35 U.S.C. 102(b) as being anticipated by Macholdt et al. US Pat. No. 5,502,118 (herein after referred to as "the '118 Patent"). The rejection of claim 1, as amended under 35 U.S.C. 102(b) as being anticipated by Macholdt et al. US Pat. No. 5,502,118 should be withdrawn for the reason that the '118 Patent does not disclose all of the elements of Applicant's invention. As amended, claim 1 included the elements of claims 2 and 4 which includes the recitation that the layered double hydroxide salt contains  $Mg^{2+}$  and  $Al^{3+}$  which is not found in the '118 Patent and thus can not be said to be anticipated by the '118 Patent. It is fundamental that all elements of a claim must be found united in the same way to perform the identical function for a reference to establish anticipation. Anticipation is a technical defense which must meet standards: Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a single prior art reference, there is no anticipation. Unless all of the elements of a claimed invention can be found in a single reference, it cannot be said that such a claim is anticipated by that reference. Therefore, the rejection of claim 1, as amended under 35 U.S.C. 102(b) as being anticipated by the '118 Patent should be withdrawn for the reason that the '118 Patent does not disclose all of the elements of Applicant's invention. The rejection of claims 23, 6-8, 10, 11, 15-17, and 22-24 under 35 U.S.C. 102(b) as being anticipated by Macholdt et al. (US Patent No. 5,502,118) should be withdrawn for the reasons given in support of amended claim 1 from which they depend.

Claims 12 and 18 were rejected under 35 U.S.C. 102(b) as being anticipated by Michel et al. (US Pat. No. 6,207,335) (herein after referred to as "the '335 Patent"). The rejection of claim 12, as amended under 35 U.S.C. 102(b) as being anticipated by Michel et al. (US Pat. No. 6,207,335) should be withdrawn for the reason that the '335 Patent does not disclose all of the elements of Applicant's invention. As amended, claim 12 now recites that the at least one layered double hydroxide salt comprises a calcined hydrotalcite or an uncalcined hydrotalcite, and thus can not be said to be anticipated by the '335 Patent. It is fundamental that all elements of a claim must be found united in the same way to perform the identical function for a reference to establish anticipation. Anticipation is a technical defense which must meet standards: Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a single

prior art reference, there is no anticipation. Unless all of the elements of a claimed invention can be found in a single reference, it cannot be said that such a claim is anticipated by that reference. Therefore, the rejection of claim 12, as amended under 35 U.S.C. 102(b) as being anticipated by the '335 Patent should be withdrawn for the reason that the '335 Patent does not disclose all of the elements of Applicant's invention. The rejection of claim 18 under 35 U.S.C. 102(b) as being anticipated by Michel et al. (US Pat. No. 6,207,335) should be withdrawn for the reasons given in support of claim 12 from which claim 18 depends.

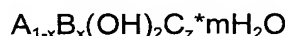
Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,502,118 to Macholdt et al. as applied to claim 1 above, and further in view of US Patent No. 5360859 to Ogawa et al. The rejection of claims 4 and 5 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,502,188 (the '118 Patent) to Macholdt et al. as applied to claim 1 as amended above, and further in view of US Patent No. 5360859 (the '859 Patent) to Ogawa et al. should be withdrawn for the reason that the '118 Patent is silent on Applicant's specific double layered Mg/Al hydroxide salts containing organic anions A, and the '859 Patent relates to the field of stabilizing resins and is silent on any method for controlling the charge of an electrophotographic toner. Clearly, no one skilled in the art armed with either the '118 Patent or the '859 Patent would have any teaching or suggestion to arrive at Applicant's invention without the use of improper hindsight. Applicant's amended claim 1 is directed to a process for controlling the charge of an electrophotographic toner and no one skilled in the art charged with solving the problem of Applicant would find any teaching or suggestion to arrive at Applicant's process. Therefore, the rejection of amended claim 1 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,502,188 (the '118 Patent) to Macholdt et al. as applied to claim 1 as amended above, and further in view of US Patent No. 5360859 (the '859 Patent) to Ogawa et al. should be withdrawn for the reason that the '118 Patent is silent on Applicant's specific double layered Mg/Al hydroxide salts containing organic anions A, and the '859 Patent relates to the field of stabilizing resins which is not for the same purpose as Applicant's invention and is silent on any method for controlling the charge of an electrophotographic toner.

Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Macholdt et al. (US Pat. No. 5,502,118) (herein after referred to as "the '118 Patent") as applied to claim 1 above, and further in view of US Patent PGPub 20030215731, Saiki et al. (hereinafter as the '731 Publication). The rejection of claim 9, under 35 U.S.C. §103(a) as being unpatentable over Macholdt et al. (US Pat. No. 5,502,118) as applied to claim 1

above, and further in view of US Patent PGPub 20030215731, Saiki et al. should be withdrawn for the reason that the '118 as discussed hereinabove fails to teach that the salt is in the form of a hydrotalcite, and no combination of the '118 Patent and the '731 Publication can be made because the '731 Publication is not prior art to the instant application. Attached to this response is a certified copy of Applicant's priority document DE10235571.1, having a filing date of 2002-August 03, and a certified translation of the priority document.

Claims 25 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Macholdt et al. as applied to claim 24 above, and further in view of US Patent No. 6,207,335 to Michel et al. The rejection of claim 25 and 26 under 35 U.S.C. §103(a) as being unpatentable over Macholdt et al. as applied to claim 24 above, and further in view of US Patent No. 6,207,335 to Michel et al. is moot in view of Applicant's amendment which canceled claims 25 and 26.

Claims 13, 14, 19, 20 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,728,366 to Martin et al. The rejection of claims 13-14 and 20-21 as amended under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,728,366 to Martin et al. should be withdrawn for the reason that the compositions disclosed in Martin include thousands of possible magnesium-aluminium hydrotalcites of the formula




wherein A is a polyvalent anion, x is 0.09-0.67,  $z=x/n$ , where n is the charge of the anion and m is 0.5-2. A is disclosed to be  $Mg^{2+}$ , B is disclosed to be  $Al^{3+}$  and C is an alkyl group with 1 to 30 carbons which include sebacates and succinates which can be substituted with a variety of groups including sulfo and halogens (Col 7, lines 1-18). Martin does not disclose Applicant's claimed range for the combination of the hydrotalcite with C. Applicant discloses and claims a range of from 1 to 45% by weight of a combination of sebacic acid and a C12-C44 fatty acid or a partially fluorinated or perfluorinated sulfosuccinic acid (C6-C22)alkyl monoester wherein the ratio between the sebacic acid and the fatty acid or the sulfosuccinic monoester is from 1:50 to 5:1. Furthermore, with reference to the Specification, Applicant has demonstrated unexpected results for the claimed combination over the use of sebacic acid alone. The claimed combination provides a rise to a significantly higher negative charge (after an activation time of about 2 hours) as shown on page 26 for example 14 (sebacic acid/stearic acid) having a charge of  $-43 \mu C/g$  versus Table Ex.'s 7, 8, 11, and 12 (sebacic

acid alone) having a charge of at most of  $-30 \mu\text{C/g}$ . Regarding claim 19, which is drawn to a combination of the hydroxide carbonate in combination with from 0.5 to 70 percent by weight of a partially fluorinated or perfluorinated sulfosuccinic acid ( $\text{C}_6\text{-C}_{22}$ )alkyl monoester, Applicant has provided an example in the Table on page 26 of Applicant's Specification where Ex 13a having a charge of  $-40 \mu\text{C/g}$  is remarkably higher negative charge than the previously mentioned examples 7, 8, 11, and 12 based solely on sebacic acid alone. No one skilled in the art would have any motivation to select Applicant's compositions from the overly broad disclosure of the '366 Patent. Clearly Applicant's invention is unobvious based on Applicant's showing of unexpected results. Therefore, rejection of claims 13-14, 19 and 20-21 as amended under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,728,366 to Martin et al. should be withdrawn for the reason that no one skilled in the art would be motivated to select Applicant's composition solely from the overly broad disclosure of the '366 Patent, particularly in view of Applicant's showing of unexpected results in controlling the charge of an electrophotographic toner, developer, etc. for Applicant's claimed combination of a particular magnesium-aluminum hydroxide carbonate with from 1-45% of a combination of sebacic acid and a  $\text{C}_{12}\text{-C}_{44}$  fatty acid or a partially fluorinated or perfluorinated sulfosuccinic acid ( $\text{C}_6\text{-C}_{22}$ ) alkyl monoester.

Accordingly, favorable reconsideration and an allowance of all pending claims are courteously solicited.

An early and favorable action is courteously solicited.

Respectfully submitted,

  
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